



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/627,386	04/04/1996	GUNTER BAUR	MERCK-1753-D	8932

7590

06/04/2002

MILLEN WHITE ZELANO & BRANIGAN
ARLINGTON COURTHOUSE PLAZA I
2200 CLARENDON BLVD SUITE 1400
ARLINGTON, VA 22201

EXAMINER

PARKER, KENNETH

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 31

Application Number: 08/627,386

Filing Date: 04/04/1996

Appellant(s): Baur et al

MAILED

JUN 03 2002

GROUP 2800

Csaba Henter, Anthony Zelano

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/28/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment of 2/28/02 cancelling claims 86 and 87 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No new prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. *Claim 20-35, 37-85, 88-124 (all claims) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,841,498.*

This rejection is set forth in prior Office Action, Paper No. 24.

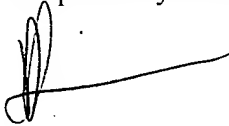
2. *Claim 20-35, 37-85, 88-124 (all claims) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,841,499*

This rejection is set forth in prior Office Action, Paper No. 24.

As applicant has not argued patentable distinctness of the current claims from the claims of the patent, but that the previously filled terminal disclaimer to patent # 5,576,867 obviates the need to file new terminal disclaimers to patents #5,841,498 and #5,841,499 (the patents in question). Applicant argues that since patents #5,841,498 and 5,841,499 are themselves terminally disclaimed to patent # 5,576,867, no difference in term will occur between those patents and the instant application, so the requirements of a terminal disclaimer have been met. As indicated on page 2 of the rejection, the nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Van Ornum*, 686 F.2d 937

In the instant case, if the maintenance fees are not paid on patent # 5,576,867, the patents in question and the instant application could be separately assigned, so the public policy objective set forth by the court to prevent possible harassment by multiple assignees would not be achieved by the previously filled terminal disclaimer. Therefore, terminal disclaimers to patents #5,841,498 and #5,841,499 are still required. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Kenneth Parker

Primary Examiner

December 6, 2001

Conferees - TD